



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Eiichi KAMIYAMA et al.

Group Art Unit: 3747

Application No.: 10/582,158

Examiner: N. KAMEN

Filed: June 8, 2006

Docket No.: 128191

For: MOUNT APPARATUS FOR VARIABLE COMPRESSION RATIO INTERNAL COMBUSTION ENGINE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

A Notice of Appeal is attached. Reconsideration of the January 28, 2008 Final Rejection is respectfully requested in light of the following remarks.

Claims 1 and 5-9 are pending in this application. The January 28 Office Action, on page 2, continues to reject claims 1 and 5-9 under 35 U.S.C. §103(a) as being unpatentable over JP-A-57-132051 (hereinafter "JP '051") in view of JP-A-04-015122 (hereinafter "JP '122"). Applicants believe that upon review of the current rejections, the Review Panel will determine that the January 28 Office Action fails to make a *prima facie* case for obviousness of the pending claims in view of this combination of references.

The Office Action notes that JP '051 teaches a variable compression ratio engine. The Office Action concedes that JP '051 teaches no manner by which to mount the engine in the vehicle. The Office Action contends that, based on the JP '051 reference being silent as to any mounting for a variable compression ratio engine in a vehicle, virtually any mounting including alleged

mountings described in JP '122 could be used, and reasonably combined with the invention disclosed in JP '051 to render obvious the subject matter of the pending claims.

Applicants have, on four previous occasions, argued that the rejections of at least independent claim 1 are incomplete, and do not meet the applicable standards for showing why one of ordinary skill in the art would have combined the references in the manner suggested with any degree of predictability, or any reasonable expectation of success. In each previous instance, subsequent Office Actions have responded, in the Response to Arguments sections, generally indicating that, because there is no mount shown in JP '051, one of ordinary skill in the art would have been forced to look elsewhere. The Office Actions go on to attempt to rebut Applicants' arguments by asserting that given the disclosure of a support structure for an engine in JP '122, there is nothing in JP '122 that would preclude its use with a variable compression engine even though a fixed compression engine is that which is shown. This is generally the totality of the argument that is set forth to support the conclusion that both references would suggest the asserted combination. This conclusion, now in several Office Actions, is considered to stretch the limits of reasonability regarding the required showing to support an obviousness rejection. "Nothing to preclude" mischaracterizes the disclosure of JP '122 and, moreover, is not the applicable standard.

Applicants reasserted specific arguments regarding the inadequacy of the combination of currently-applied references with respect to the subject matter of the pending claims in a Request for Reconsideration After Final Rejection filed on March 17, 2008. In response, an Advisory Action was mailed on April 2, 2008, which stated, in pertinent part, that the Examiner maintains the position that combining the references is reasonable, that one of ordinary skill in the art would look to the secondary reference for guidance on how to mount the engine of the primary reference. The ongoing analysis of the Office Actions and now the Advisory Action fails for at least the following reasons.

Claim 1 recites a mount apparatus for mounting a variable compression ratio internal combustion engine in which the compression ratio can be varied by moving a cylinder block and a

crank case relatively along the actual direction of a cylinder on a vehicle body member, wherein: said variable compression ratio internal combustion engine is mounted on said vehicle body member by at least two portions including a first mount portion provided on a transmission apparatus to which a crank shaft is linked and a second mount portion provided on the variable compression ratio internal combustion engine in a state in which said cylinder block is located above said crank case; and said second mount portion is provided on said crank case and wherein the variable compression ratio internal combustion engine is mounted on the vehicle body member such that the cylinder block moves relatively to the vehicle body member a greater distance than the crank case moves relative to the vehicle body member, when the compression ratio is varied. Because of the unique configurations of variable compression ratio engines, it is not as simple a matter as the series of Office Actions indicates that any suggested conventional capability by which to mount an engine in a vehicle may be referenced. Specifically, it is clear from the claim language that portions of the engine are intended to move greater distances relative to one another. In fact, the engine is designed in a manner to do just that. It is for this reason that conventional mounting may not be appropriate. In fact, in the background and description sections of Applicants' disclosure, it is specifically noted that conventional means of mounting engines in vehicles have certain specifically described and enumerated shortfalls.

The argument that there is nothing in JP '122 that would preclude its use with a variable compression engine is not supportable based on the disclosure of that reference as is carefully explained in the background of Applicants' specification. Further, even if "there is nothing to preclude its use" were the applicable standard, JP '122 shows a configuration in which the cylinder block is supported, and not the crank case. This positive disclosure in JP '122 is discounted by the Office Actions indicating that "[t]he Examiner contends that all engines require mounting structure, and because JP '051 lacks any teaching of what mounting structure to use, one of ordinary skill in the art would be forced to look elsewhere." The Office Actions go on to assert the previous standard by which the Examiner seems to believe he can make the argument that JP '122 apparently,

in the Examiner's opinion, does not preclude its use with a variable compression engine. The Office Action also asserts that the Abstract of JP '122 sets forth merely one embodiment of the invention and that Fig. 3, albeit perhaps a less desirable embodiment, clearly shows the crank case being supported.

The conclusion misconstrues the positive disclosures of the totality of JP '122 which are designed, in a fixed compression ratio engine, to overcome shortfalls of crank case mounts. Therefore, it is unreasonable to consider, even if one of ordinary skill in the art may have chosen to combine JP '122 in some manner with the variable compression ratio engine that they would have been directed toward a configuration that includes crank case mounting, which is clearly disclosed as being inferior in JP '122, and an objective to which the subject matter of JP '122 is intended to overcome. In other words, it has not been clearly shown that one of ordinary skill in the art would have combined these references with any degree of predictability, or any reasonable expectation of success, based specifically on the varying disclosures upon which the Office Actions have routinely attempted to rely in attempting to render obvious the subject matter of the pending claims. Again, Applicants assert that a *prima facie* case for obviousness based on this loosely connected string of suppositions does not meet the required standard.

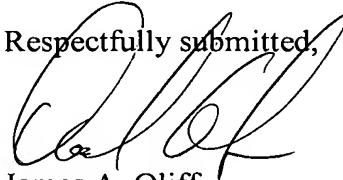
Throughout the prosecution of this application, the Office Actions, including the Office Action to which the most recent Request For Reconsideration After Final Rejection responded, have not shown any reasonable predictability regarding why one of ordinary skill in the art would have made the asserted combination, or any reasonable expectation of success, in addressing the objectives that are addressed by the subject matter of the pending claims by making such a combination. Rather, the Office Actions have routinely simply asserted that these references are combinable because the Office Actions say they are in rendering obvious the subject matter of the pending claims. Even under a post-KSR analysis, this does not meet the standard for a required showing under any rationale to support the conclusion of obviousness regarding how the asserted combination would have yielded any predictable results. In fact, quite to the contrary, the

disclosure of JP '122 arguably teaches away from using the "inferior method," which the argument in the most recent Office Action ignores. The ongoing use of mere conclusory statements to support a conclusion which is not shown in, or reasonably supported by, the references, or otherwise in the prior art, for which no logical, rationale objective evidence of record has been provided, is without merit.

For at least the foregoing reasons, JP '051 and JP '122 are not combinable in the manner suggested by the Office Action, and any permissible combination of these references would not reasonable have suggested the combination of all of the features positively recited in independent claim 1, and the claims depending therefrom.

In view of the foregoing, Applicants believe that upon review of the substance of the January 28, 2008 Office Action, the Review Panel will find that a *prima facie* case for obviousness of the subject matter of the pending claims over the asserted references has not been shown.

Should the Review Panel believe that anything further would be desirable in order to place this application in even better condition for allowance, the Review Panel is invited to contact Applicants' undersigned representative at the telephone number set forth below.

Respectfully submitted,

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JAO:DAT/cfr

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